

## **Remarks/Arguments**

### **A. Status of the Specification**

The specification is revised to correct a typographical error. The sentence on page 2, line 30, now recites (editing indicia included): “Typically, the surface roughness Rq of the polished face of the lens blank ranges under 0.01 μm, preferably around 0.05 0.005 μm.”

This amendment does not introduce new matter, as the revision corrects an obvious typographical error that would be clear to a person having ordinary skill in the art. By way of example, a roughness of 0.05 μm cannot define a polished state, so the person of ordinary skill in the art would conclude that this is a mistake. In fact, a roughness of 0.05 μm defines a fined state. See specification at page 2, lines 24-25 (“Typically, the Rq of the fined face is above 0.01 μm, and preferably ranges from 0.05 to 1.5 μm, more preferably from 0.1 to 1.0 μm.”).

Applicant requests that this amendment be introduced into the specification. MPEP § 2163.07[II] (“An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.”).

### **B. Status of the Claims**

Claims 1, 8, 10, 14, 25, 27, 32, 34, 36, 41, and 43 are amended, claims 28 and 35 are canceled, and claim 44 is added. Support for these amendments can be found throughout the specification and claims as originally filed. Non-limiting examples of support are at page 6, lines 23-24; page 8, lines 19-20; and page 12, lines 6-8 (examples of single optical articles have only one coating).

Claims 1-27, 29-34, and 36-44 are pending.

### **C. Claim Objections Are Overcome**

Claims 9-10, 29, and 34-35 are objected to for various reasons. These objections have been addressed in the listing of claims above. Applicant requests that the objections be withdrawn.

### **D. Obviousness-Type Double Patenting Rejections Are Overcome**

The following obviousness-type double patenting rejections are presented by the Examiner:

1. Claims 1-43 are rejected as being unpatentable over claims 1-33 of U.S. Patent No. 6,562,466.
2. Claims 1-43 are provisionally rejected as being unpatentable over claims 22-64 of co-pending Application No. 10/838,840.
3. Claims 1-43 are provisionally rejected as being unpatentable over claims 20-62 of co-pending Application No. 10/862,693.
4. Claims 1-43 are provisionally rejected as being unpatentable over claims 25-38 of co-pending Application No. 10/861,580.

Applicant disagrees with these obviousness-type double patenting rejections. Applicant notes that a one-way obviousness test is appropriate for the first rejection. However, a two-way obviousness determination is appropriate for rejections 2-4 for at least two reasons: (i) the present application was filed on December 31, 2003 which is prior to the applications cited in 2-4 (*i.e.*, May 4, 2004, June 7, 2004, and June 4, 2004, respectively); and (ii) Applicant does not have complete control over the rate of progress of the present application or the later-filed applications in 2-4. *See In re Braat*, 937 F.2d 589 (Fed. Cir. 1991) (“Where, through no fault of the applicant, the claims in a later filed application issue first, an obviousness-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office.”).

With this framework in mind, Applicant will address each rejection in the following subsections.

**1. Claims 1-43 are patentable over claims 1-33 U.S. Patent No. 6,562,466 (“Jiang *et al.*”)**

***The Jiang et al. claims are directed to a process that transfers at least two coatings to a lens blank***

The difference between the scope of the pending claims and those in Jiang *et al.* is that the pending claims are directed to processes where an optical article is obtained that is “free of visible fining lines having said at least one fined by unpolished geometrically defined main face coated with only one coating” (claim 1) and a coated article is obtained that has “a surface state corresponding to a polished state, wherein the main face is coated with only one coating” (claim 36). By comparison, the independent claims concern processes where at least two coatings (*e.g.*, “curable glue” and a “coating”) are transferred to a lens blank. Jiang *et al.* at claims 1 and 19. These are patentably distinct differences.

The Examiner’s assertion that the instant claims are made obvious by column 3, lines 5-16 of Jiang *et al.* is incorrect for at least three reasons. First, there is no apparent reason to combine the two following features, in order to make obvious the instant claims:

- A deposition onto a fined but unpolished surface, rather than “an optical surface”, which means a ground, fined and polished surface; and
- The application onto said surface of only one coating rather than a layer of a curable composition and an additional coating borne by the mold part or a stack of several coatings borne by the mold part.

Rather, Jiang *et al.* discloses that the external layer of the stack to be transferred can be a curable glue. Since the term “external layer” is used, it means that other layers are present on the mold part. Jiang *et al.* at col. 3, lines 5-8 (“In one embodiment of the process of the invention, the pre-

measured amount of the curable glue may consist in the external layer of the coating itself, in particular an impact-resistant primer layer of the coating to be transferred.”) (underline added).

Second, Jiang *et al.* does not contemplate the embodiment in which the curable glue layer is the only one coating to be transferred. As illustrated by the examples of this Patent, a stack comprising an impact resistant primer, an abrasion resistant coating and an antireflection coating is generally transferred onto the substrates (said stack is called HMC, this term being defined in example 7).

Third, Jiang *et al.* contemplates the simple transfer of an antireflection coating in the description, albeit this coating is a multilayer coating in which the external layer is the curable glue (see example 10, “dielectric multilayer AR coating”). *Id.* at col. 3, lines 13-16 (“It also can be the external layer of an anti-reflective coating, in particular when only such an anti-reflective coating is being transferred. In that case, of course, the anti-reflective coating is deposited in a liquid form.”).

***The Jiang et al. claims teach away from Applicant’s present claims***

A reference is said to teach away from a claimed invention “when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

The Jiang *et al.* claims teach away from Applicant’s claimed “only one coating” transfer process. As explained in detail above, a person of ordinary skill, upon reading Jiang *et al.*, would be led to use a multiple coat transfer process. *See above*. For instance, such a person would have been led to transfer a stack of several coatings onto a fined but unpolished surface,

leading to a high global thickness. This is divergent from Applicant's claimed "only one coating" transfer process.

The fact that the Jiang *et al.* claims teach away from Applicant's claimed invention is additional evidence confirming that the double patenting rejection is improper. *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003) ("[A]n applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect.").

Applicant requests that this double patenting rejection be withdrawn.

**2. Claims 1-43 are patentable over claims 22-64 of co-pending Application No. 10/838,840 ("‘840 Application")**

Independent claim 22 of the ‘840 Application describes a coating transfer process from a carrier toward a substrate based on the use of a glue composition that is disclosed for the first time in the ‘840 Application. Independent claim 61 of the ‘840 Application describes a process for overmolding a coating on a substrate based on the use of the same glue. Claims 22 and 61 are not an obvious variation of the claims in the present applications. The two-way obviousness determination confirms this.

Applicant requests that this provisional double patenting rejection be withdrawn.

**3. Claims 1-43 are patentable over claims 20-62 of co-pending Application No. 10/862,693 ("‘693 Application")**

The scope of the claims in the ‘693 Application is similar to those of the ‘840 Application since they both concern a transfer process (independent claim 20) and an overmolding process (independent claim 55) based on the use of another new glue. The analysis set forth in the above section equally applies here.

Applicant requests that this provisional double patenting rejection be withdrawn.

**4. Claims 1-43 are patentable over claims 25-38 of co-pending Application No. 10/861,580 (“‘580 Application”)**

Claim 25 of the ‘580 Application concerns a process for the application of a coating on a torical surface of an optical article from a curable composition. A two-way obviousness determination overcomes the rejection, since the inventions defined in the claims of the ‘580 Application are not an obvious variation of the inventions defined in the instant claims.

By way of example, the present claims do not concern the following features of the process according to the ‘580 Application:

the liquid curable composition deposition step comprises depositing on the toric surface at least two drops of the liquid curable composition, each within one of two opposite sectors centered on the first principal meridian of lower radius of curvature  $r$  and having an apex angle up to 40.

Applicant requests that this provisional double patenting rejection be withdrawn.

**E. The Indefiniteness Rejections Are Overcome**

The Examiner contends that the phrase “the internal face” in claims 1 and 36 lack antecedent basis. Applicant notes that these claims have been revised to address this issue.

Claims 1 and 36 are also rejected because the phrase “fined but unpolished” is allegedly unclear. Applicant disagrees. This phrase is clear. For instance, the specification clearly explains that mechanical surface treatment of an optical article typically includes three steps (grinding, fining, and polishing) and provides a description of each step. Specification at page 2, lines 9-28. The description of these three steps is sufficient for a person skilled in the art to understand that the phrase “fined but unpolished” includes the use of an article having at least one geometrically defined surface which has been subjected to a fining process but not a polishing process. Therefore, this phrase is clear and the indefiniteness rejection should be withdrawn.

The Examiner also takes the position that the phrase “optical lens blank” in claim 1 is unclear because dependent claims 27, 29, 31, and 32 recite different optical articles. Applicant notes that the claims have been revised, where appropriate, to address this issue.

Claim 14 is allegedly indefinite because the phrase “flexible plastic material” lacks antecedent basis. Claim 14 now depends from claim 13, thereby solving the antecedent basis issue.

Claim 32 is allegedly indefinite because it is unclear whether the tinted optical article is a tinted lens or a tinted lens blank. This claim has been revised to address this issue.

Claim 4 is allegedly indefinite because the term “flexible” is a relative term. Applicant disagrees. The “flexible” mold part in claim 4 means a deformable mold part, where the surface is capable to adapt to the general shape of the optical article to be coated, as opposed to a rigid mold part, which internal surface must inversely replicate the surface of the optical article to be coated. This is explained in the specification:

The mold part may be rigid and its internal face inversely replicates said main face of the optical article. [Specification at page 7, lines 33-34].

The mold part may be flexible and its internal face inversely replicates said main face of the optical article under the pressure applied in step (v). [Specification at page 8, lines 1-3].

When using this flexible wafer, it is only necessary to provide the wafer with a surface the geometry of which conforms to the general shape of the optical surface of the lens blank onto which the coating is to be applied, either a concave or convex shape, but it is not necessary that this surface strictly corresponds to the geometry of the lens blank surface to be coated. Thus, the same flexible wafer can be used for applying coatings onto lens blanks having surfaces of different specific geometries. Generally, the flexible wafer has two parallel main surfaces and consequently has an even thickness. [Specification at page 8, lines 18-26].

The inflatable membrane can be made of any elastomeric material which can be sufficiently deformed by pressurization with appropriate fluid for urging the flexible wafer against the lens or lens blank in conformity with the surface geometry of the lens or the lens blank. [Specification at page 9, lines 7-10].

Applicant requests that the indefiniteness rejection for the term “flexible” be withdrawn for at least the above reasons.

#### **F. The Anticipation Rejections Are Overcome**

The Examiner presents two anticipation rejections in view of U.S. Patent 5,512,371 (“Gupta *et al.*”) and U.S. Patent 6,562,466 (Jiang *et al.*). In the first, claims 1-7, 13, 15-20, 26-28, 30, 32, 34, 36, and 37 are said to be anticipated under 35 U.S.C. § 102(b) by Gupta *et al.* Claims 1-28, 30, 32-34, 36, and 37 are said to be anticipated under 35 U.S.C. § 102(e) by Jiang *et al.*

Applicant disagrees with both rejections. For instance, Gupta *et al.* fails to disclose Applicant’s claimed optical article “having said at least one fined but unpolished geometrically defined main face coated with only one coating.” Rather, this reference discloses a transfer process onto a lens that can be “finished” or “semi-finished.” Neither the finished or semi-finished lens includes a “fined but unpolished” surface. As for the Jiang *et al.* reference, it appears to disclose a transfer process where at least two coatings are transferred to it which is distinct from Applicant’s claimed “only one coating” process. These arguments are explained in detail in the following sections.

##### **1. Gupta *et al.* fails to disclose every element of Applicant’s Invention**

Independent claims 1 and 36 are directed to processes where an optical article is obtained that is “free of visible fining lines having said at least one fined by unpolished geometrically defined main face coated with only one coating” (claim 1) and a coated article is obtained that has a coating transferred to a “fined but unpolished geometrically defined main face” (claim 36). At least these claimed elements are not disclosed by Gupta *et al.* See *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every



element of the claimed invention must be identically shown in a single reference. These elements must be arranged as in the claim under review ....”).

By comparison, Gupta *et al.* discloses a process for the application of a coating onto the surface of a lens, the process including disposing a curable optical quality resin composition between a plastic lens and the surface of a mold. See Gupta *et al.*, col. 1, lines 52-59. After curing, a cured coating is obtained that is bonded to the lens preform. *Id.* The lens surface receiving the coating is either a “finished” or “semi-finished” surface. *Id.* at col. 3, lines 34-36. The “semi-finished” lens surface is not Applicant’s claimed “fined but unpolished” surface.

Rather, a semi-finished lens is defined as having only one optically finished surface, which is obtained after having subjected the lens to a surfacing process (*i.e.*, grinding, fining and polishing). Upon reading this reference, it is not clear whether the coating is overmolded on the surfaced face or the non surfaced face of the lens. Two hypotheses can be made:

- i) If the coating is applied on the finished surface of the lens, the latter consequently had a polished surface state before the implementation of the process, which is contrary to the teaching of the present claims.
- ii) If the coating is applied on the unfinished surface of the lens, *i.e.*, non surfaced, said surface has not been fined, which is also contrary to the teaching of the present claims.

As a conclusion, Gupta *et al.* fails to disclose a transfer process, where an optical article free of visible fining lines having said at least one fined but unpolished geometrically defined main face coated with only one coating is obtained. Because Gupta *et al.* fails to disclose every element of Applicant’s claimed processes, the anticipation rejection cannot be maintained. Applicant requests that this rejection be withdrawn.

## **2. Jiang *et al.* fails to disclose every element of Applicant's Invention**

As explained above, Jiang *et al.* does not disclose or suggest a process that results in only one coat being transferred to a lens blank. Rather, this reference discloses and claims processes in which at least two coatings are transferred to the blank. *See above* at section (D)(1). This is sufficient to overcome the anticipation rejection. *See In re Bond*, 910 F.2d at 832.

Because Jiang *et al.* fails to disclose several aspects of Applicant's claimed invention, the anticipation rejection cannot be maintained. Applicant requests that this rejection be withdrawn.

## **G. The Obviousness Rejections Are Overcome**

Six separate obviousness rejections against specific dependent claims are presented by the examiner:

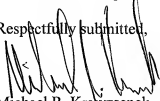
- (i) Claims 29 and 35 are rejected under 35 U.S.C. § 103(a) as being obvious over Jiang *et al.* in view of U.S. Patent 6,489,028 to Degand *et al.*;
- (ii) Claims 31 and 38 are rejected under 35 U.S.C. § 103(a) as being obvious over Jiang *et al.* in view of U.S. Patent 5,753,301 to Brytsche *et al.*;
- (iii) Claim 39 is rejected under 35 U.S.C. § 103(a) as being obvious over Jiang *et al.* in view of Brytsche *et al.* and further in view of U.S. Patent 5,254,000 to Friske *et al.*;
- (iv) Claims 40 and 42 are rejected under 35 U.S.C. § 103(a) as being obvious over Jiang *et al.* in view of U.S. Patent 6,565,776 to Li *et al.*;
- (v) Claims 41 and 43 are rejected under 35 U.S.C. § 103(a) as being obvious over Jiang *et al.* in view of U.S. Patent 6,491,851 to Keller *et al.*; and
- (vi) Claims 9, 10, 12, 14, 29, and 35 are rejected under 35 U.S.C. § 103(a) as being obvious over Gupta *et al.*

Applicant disagrees with these rejections. Each of the rejections concern dependent claims. Given the fact that the independent claims are novel (see above), it follows that the dependent claims are also novel. Therefore, the obviousness rejection cannot be maintained and should be withdrawn.

## H. Conclusion

The present claims are in a condition for allowance, and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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